

REMARKS

Applicants thank the Examiner for the thorough consideration given the present application.

Claims 4-12 are pending. Claims 4 and 5 are independent. Claims 4 and 5 have been amended to further emphasize the distinctions between the present invention and the cited art. These amendments are fully supported by, for instance, the present specification at page 8, lines 22-25 and page 9, lines 1-3. Therefore, no new matter has been added.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Issues under 35 U.S.C. §§ 102(e)/103(a)

The Examiner has rejected claims 4-12 under 35 U.S.C. § 102(e) as being anticipated by Ueda et al. USP 6,831,103 (hereinafter referred to as Ueda '103). Also, the Examiner has rejected claims 5 and 7-12 under 35 U.S.C. § 103(a) as being obvious over Ueda '103 in view of Hamilton (J. Neurol. Neurosurg Psychiat, 1960, 23, 56).

Applicants respectfully traverse this rejection.

While not conceding to the Examiner's rejections, but to merely expedite prosecution, claims 4 and 5 have been amended to indicate that the mood disorders are distinct from mood disorders associated with menstruation. By way of this, the present invention is not disclosed or made obvious by the cited art for at least the following reasons.

The present invention is directed to a method for ameliorating mood disorders comprising administering an effective amount of a composition comprising theanine to a person in need

thereof, wherein said mood disorders are distinct from mood disorders associated with menstruation, as recited in claim 4. Claim 5 contains a similar subject matter.

To the contrary, the primary reference, Ueda '103 is directed to a theanine-containing composition for suppressing and ameliorating various symptoms accompanying diminished homeostasis, such as obesity, anxiogenic symptoms, sensitivity to cold, sleep disorders, autonomic imbalance, premenstrual syndrome, and menopausal disorders. See, column 3, lines 49-59 of Ueda '103. However, obesity, anxiogenic symptoms (panic disorders characterized by severe anxiety due to continuous or habitual intake of methylxanthine derivatives), sensitivity to cold, sleep disorders, and autonomic imbalance of Ueda '103 have nothing to do with mood disorders recited in the claimed invention. Specifically, as shown in Test Examples 2-4 of Ueda '103, obesity and anxiogenic symptoms were suppressed by administration of theanine, which suppression has nothing to do with mood disorders recited in the claimed invention.

Also, the present method is patentably distinct from a method of Ueda '103 because claims 4 and 5 of the present invention require a method for ameliorating mood disorders.....wherein the mood disorders "are distinct from mood disorders associated with menstruation" while Ueda '103's mood disorders are associated menstruation. Specifically, the present specification at page 8, lines 22-25 and page 9, lines 1-3 clearly explains that the mood disorder symptoms measured by the Hamilton scale are different from those for women in a depressed state caused before (PMS) and during menstruation. Also, as disclosed in column 5, lines 9-15 and 54-65 of Ueda '103, the depressed state regarding menstruation such as PMS or menopausal disorders are related to a hormone imbalance by a high basal body temperature phase, i.e., the ovarian corpus lutea stage for PMS and by a hyper secretion of gonadotropin and

a decrease of estrogen for menopause disorders. Therefore, the mood disorders of the claimed invention cannot be equated with those of menstruation and, thus are patentably distinct from Ueda '103. Accordingly, Applicants respectfully submit that the claimed invention is not anticipated by Ueda '103. Further, the deficiencies of the primary reference Ueda '103 cannot be cured by the second reference, Hamilton, as discussed above. Therefore, the present invention is not anticipated or made obvious by the cited art, and reconsideration and withdrawal of this rejection are respectfully requested.

Meanwhile, regarding the use of negative limitation as recited in independent claims 4 and 5, Applicants respectfully submit that this negative limitation is the most proper way to distinguish the claimed method from Ueda '103, and also clearly complies with the requirements of 35 U.S.C. § 112, second paragraph based on MPEP 2173.05(i) "Negative limitation" section. The MPEP states that so long as the boundaries of the patent protection sought are set forth definitely, albeit negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph, and any negative limitation or exclusionary proviso must have basis in the original disclosure.

According to the MPEP guidelines, it is evident that the negative limitations recited in claims 4 and 5 are fully supported by, for instance, the present specification at pages 8 and 9, and that the boundaries of the patent protection sought are definite because mood disorders associated with menstruation are excluded. Therefore, this limitation complies with the requirement of 35 U.S.C. § 112, second paragraph.

Provisional Obviousness-Type Double Patenting

The Examiner has maintained a provisional rejection of claims 4-12 under the judicially created doctrine of obviousness-type double patenting as being obvious of the claims of copending Application No. 10/343,931. Applicants traverse this rejection.

While not conceding the appropriateness of the Examiner's rejection, but merely to advance prosecution of the instant application, Applicants are herewith submitting a Terminal Disclaimer disclaiming the terminal portion of any patent granted on the present application which would extend beyond the expiration of any patent which issues from U.S. Application No. 10/343,931. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

In summary, Applicants respectfully submit that the present claims define allowable subject matter. Therefore, the Examiner is respectfully requested to withdraw all rejections and allow the presently pending claims.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Reg. No. 42,874, at the offices of Birch, Stewart, Kolasch & Birch, LLP at the number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 
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